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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/388,726	09/02/99	AN	D OSTEONICS3.0

000530
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EXAMINER

PELLEGRINO, B

ART UNIT PAPER NUMBER

3738

DATE MAILED: 05/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/388,726

Applicant(s)
An et al.

Examiner
Brian Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 20, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above, claim(s) 16, 17, and 34-40 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-24 and 27-33 is/are allowed.
- 6) ☒ Claim(s) 1-15, 18, 25, and 26 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claims are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. .
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). .
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). . 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: Fig. 1.

Species II: Fig. 15.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2, 5-8, 10-15, and 26 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Kimberly Perry on 5/2/01 a provisional election was made without traverse to prosecute the invention of Species I, claims 1-15, 18-33.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 16 and 17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Rejections - 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 1, 5, 6, 10, 12, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Sagar (5702455). It can be seen (Fig. 1) that the spinal fusion device contains a first member 2 engagable with a second member 3 having a hollow tubular member 1 telescopically received in the first member 2. It can be construed that an adjustable member 4 can be locked in a locked position and engages the first and second members (2, 3) via the hollow member 1 that contains threads. Sagar teaches to use a screw 16 to lock the first and second member in a particular position. When the screw is totally screwed in it is in first locked position and when unscrewed it is in a second unlocked position. The screw can be construed as a "clip," since applicant has not disclosed what exactly a "clip" is defined as. The term "clip" is sufficiently broad to include alternatives, such as a screw, ring, pin, etc. which function to lock something in a particular position. Bone fragment receiving apertures (6, 6') can be seen in the first and second members respectively, col. 3, lines 50-52. Regarding claim 12, it can be construed (Fig. 3) that bone growth encouraging material is inserted in the cavities via apertures (6, 6'), see col. 3, lines 66-67. Figure 3 also teaches that axially extending teeth 9 protrude from first and second members, see col. 3, lines 53-55.

6. Claims 1, 5-8, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Daher (4657550). It can be seen in Fig. 2 that a vertebral device having first and second members (1, 8) with the second member "capable of being telescopically received" in the hollow opening 6 of first member 1. It can be construed that element 20 is a "locking clip" which locks the two

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members in position transverse to the longitudinal axis. The "locking clip" is movably mounted on first member 1 in bore 21. It can also be seen that perforations 22 exist on the body of first member and it can be construed that second member's (8) threads can be in the form of perforations.

7. Claims 1, 3-8, 10-15, 18, 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Studer et al. (6193756). Fig. 2 teaches a vertebral implant having first and second members (1, 2) where the second member is telescopingly received in the first member. Studer et al. teach that a "clip" in the form of a screw 32 that engages the first member to secure the elements in a desired position. The screw can be construed as a "clip," since applicant has not disclosed what exactly a "clip" is defined as. The term "clip" is sufficiently broad to include alternatives, such as a screw, ring, pin, etc. which function to lock something in a particular position. It is inherent that the screw can move into a locked and unlocked position since it is threaded and can only be screwed as far as the receiving bore permits to a locked position. It can be seen (Figs. 1, 4, 5) that body portion 1 has elongated perforations 8 in the axial direction and circular perforations 24 on the other member 2. Additionally the first and second members have outer axial ends with outwardly extending flanges 5 and 30 with teeth 23. It can be seen that the outer surface is cylindrical.

8. Claims 1-9, 13-15, 18, 25, 26 are rejected under 35 U.S.C. 102(a) as being anticipated by Schar et al. (WO 98/46173). Fig. 3 teaches a vertebral implant having a first hollow member 2 with a flange 39 having teeth 40. It can also be seen that the first member telescopingly receives second member 1 also having an outwardly extending flange 38 with teeth 40. Fig. 5 teaches the

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locking clip 13 includes at least one depression 22 and a second member has a "ridge" 21 engageable in the depression to lock the elements in a relative position. Fig. 4 teaches a locking clip 13 and second member 1 include interengaging threads for locking the elements in a particular position, see Fig. 3. The clip contains a gap that can be construed as a bore that is engaged by a screw 35 shown in Fig. 3. See US 6176881 for translation if needed.

Response to Arguments

9. Applicant's arguments filed 2/20/01 have been fully considered but they are not persuasive. Regarding the Saggari and Daher references, the examiner takes the position that the screw can be construed as a "clip," since applicant has not particularly defined what a clip is. The term "clip" is sufficiently broad to include alternatives, such as a screw, ring, pin, etc. which function to lock something in a particular position.

Allowable Subject Matter

10. Claims 19-24, 27-33 are allowed.

11. Since allowable subject matter has been indicated, applicant is encouraged to submit formal drawings in response to this Office action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

Conclusion

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12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 8am to 5:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino TC 3700, AU 3738

Bruce Snow Primary Examiner

Brian Pellegrino 5/6/09

BES